

## **REMARKS**

After entry of the foregoing amendments, claims 1, 4, 10-14, 17, 19, 20 and 23-28 are pending. Claims 1, 4, 11, 13, 14, 17, 19, 20, 23 and 25 have been amended.

Applicants submit that no new matter has been added. In particular, support for the recitation of -A-B- as a fused benzene in claims 1, 4, 13, 14, 17, 20 and 23 can be found in the specification at least at page 7, lines 24-31. The recitation in claims 11, 19 and 25 regarding the ureido group can be found in the specification at least at page 19, line 2. The recitation in claims 11, 19 and 25 regarding the sulfonamido group can be found in the specification at least at page 18, line 34. The recitation of ester and amido in claim 14 is supported in the specification at least at page 14, lines 10-26. The recitation of SO<sub>2</sub>R wherein R is C<sub>1-7</sub> alkyl, C<sub>3-20</sub> heterocyclyl or C<sub>5-20</sub> aryl in claim 14 is supported in the specification at least at page 16, lines 17-23. The remaining amendments are supported at least in the original claims.

Applicants thank the examiner for indicating that claims 26-28 are allowed.

Claims 1-4 and 10-25 stand variously rejected. The rejections are traversed as discussed below.

### **Request for Acknowledgment of Information Disclosure Statements**

Applicants respectfully request that the documents submitted in the Information Disclosure Statement filed February 5, 2002 and in the Supplemental Information Disclosure Statements filed May 14, 2002 and September 27, 2002 be considered by the Examiner and made of record in the present application. Applicants also request that an initialed copy of the corresponding Forms PTO-1449 be returned in accordance with MPEP § 609. For the convenience of the examiner, copies of the PTO Forms PTO-1449 are enclosed, as well as corresponding postcards showing timely receipt by the Office.

### **Claims readable on Elected Species**

The Office Action states that claims 1-4 and 10-18 read on the elected species, which is compound 686 in Fig. 8 of the specification. Applicants respectfully assert that in addition to the claims listed in the Office Action, claims 19-28 also read on the elected species.

### **Improper Markush Rejection**

In the Office Action, claims 1, 10-14, 18-20, 24 and 25 stand rejected as containing improper Markush groups in the definition of the -A-B- ring. Not to acquiesce to the rejection, but to advance prosecution, the claims have been amended to recite that -A-B- together represent optionally substituted benzene. Accordingly, withdrawal of the rejection is respectfully requested.

### **Provisional Obviousness-type Double Patenting Rejection**

In the Office Action, claims 1-4, 10, 12-18 and 20-24 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over copending Application Serial No. 10/426,147. Applicants respectfully request that the rejection be held in abeyance until such time that one or both of the applications issue and the rejection is no longer provisional.

### **Rejections Under 35 USC § 112, second paragraph**

In the Office Action, claims 10, 11, 18, 19, 24 and 25 are rejected as being indefinite. The Office Action states: 1) the terms “ureido” and “sulfonamido” in claims 11, 19 and 25 do not find antecedent basis in the claims from which they depend, i.e., claims 10, 18 and 24, respectively; and 2) the “acylamido” substituent in claims 10, 11, 18, 19, 24 and 25 should be “acylamino.” Applicants respectfully traverse the rejections, but have amended the claims as described below solely to advance prosecution.

With respect to 1), applicants respectfully assert that the amendment to claims 11, 19 and 25 obviate the rejection. The specification, at paragraph 76, states “[a] particular form of amino group [includes] a sulfone [moiety]... and this group can be termed a sulfonamido group.” At paragraph 77, the specification also states that “acylamido” includes “ureido.” The amendment to the claims therefore clarifies these relationships.

With respect to 2), applicants respectfully direct the examiner’s attention to paragraph 0099 of the specification where “acylamido” and “acylamino” are used synonymously and defined identically. Thus, withdrawal of the rejection is respectfully requested.

**Rejections Under 35 USC § 102(b)**

In the Office Action, claims 14-25 are rejected under 35 USC § 102(b) as anticipated by four newly cited Chemical Abstracts references. The rejections are respectfully traversed inasmuch as the references may be applied by the examiner to the amended claims.

At the outset, applicants submit that claims 20-25 are directed to pharmaceutical compositions. To anticipate a claim under 35 USC § 102(b), a cited reference must teach each and every element as set forth in the claim, either expressly or inherently. MPEP 2131. The cited Abstracts are directed only to compounds *per se* and do not teach, either expressly or inherently, inclusion of any of the compounds in a pharmaceutical composition.

The cited Fujisawa Pharmaceutical Abstract appears to indicate that the chloro-substituted compound depicted is an aldose reductase inhibitor. However, as shown in the full English Abstract (attached hereto as Exhibit A), the chloro-substituted compound depicted is merely an intermediate in the preparation of the 2-carboxyalkyl-4-arylphthalazine derivatives that exhibit aldose reductase activity. There is no suggestion that such intermediates could be included in a pharmaceutical composition.

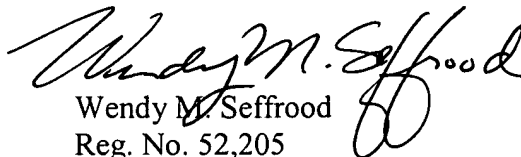
Thus, applicants respectfully request withdrawal of the rejection of claims 20-25 under 35 USC § 102(b).

With respect to the rejection of claims 14-19, which are directed to compounds, applicants respectfully submit that the amended claims are not anticipated by any of the compounds depicted in the Chemical Abstracts. Therefore, withdrawal of the rejections under 35 USC § 102(b) is respectfully requested.

### CONCLUSION

In view of the foregoing, reconsideration and allowance of claims 1, 4, 10-14, 17, 19, 20 and 23-28 is respectfully requested. The Examiner is strongly encouraged to contact the undersigned by telephone at the Examiner's convenience should any issues remain with respect to the Application.

Respectfully submitted,

  
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